

Appl. No. 09/868,256  
Atty. Docket No. AA-374  
Amdt. dated 6/18/2003  
Reply to Office Action of 12/18/2002  
Customer No. 27752

### REMARKS

The Examiner's 35 U.S. C. 103(a) Rejection - Sumida-Japanese HEI 4(1992)-48925 in view of Motono (US 4985455)

The Examiner asserts that the instant application is unpatentable over Sumida in view of Motono (US 4,985,455). Sumida discloses a transparent microemulsion made by pre-emulsification using high pressure equipment such as a microfluidizer. The citation states at Comparative Example 1 "without the use of a microfluidizer, a microemulsion is not formed." Therefore, no motivation is provided to explore a combination of surfactants, which would solubilize the oil without the use of a microfluidizer.

On the other hand, the instant invention at page 4, lines 8-10 states: "...it is believed that the combination of surfactants significantly increases the oil solubilization" (emphasis mine). It is significant therefore that Sumida does not teach or imply using the POE tetraalkyl esters of the presently claimed composition. Sumida teaches mono, tri and penta alkyl esters including POE monooleates, monostearates, trioleates and pentaoleates, however, not tetra alkyl esters. One skilled in the art, noticing the conspicuously avoidance of tetra alkyl esters would actually be taught away from applying them to the presently claimed compositions.

In order to overcome the absence of the POE tetraalkyl esters, the Examiner asserts that Sumida should be viewed in light of Motono. Motono discloses external preparations comprising kojic acid, or a derivative thereof, which also contain an ultraviolet absorber,  $\beta$ -cyclodextrin and ethylenediaminetetraacetic acid and have a controlled pH in the range of from 4.0 to 5.0. One of the cited Examples includes the use of polyoxyethylene sorbitol tetraoleate. The preparation of the aqueous portion of the final composition is described and the aqueous solution is stated to be "clear". However, there is no claim of clarity for the final emulsion.

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The MPEP at Section 2143 states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally the prior art references must teach or suggest all the claim limitations."

Certainly, there is no motivation provided by Sumida to add the instant surfactant combination. In fact there is no motivation to change any component in order to remove the necessity to microfluidize. In addition, there is no reason to believe that any component used in Motono would result in a successfully solubilized product, including the polyoxyethylene sorbitol tetroate. If one were to pick and choose individual components (based on a reading of the instant disclosure) and then construct a claim which contained the elements of the instant invention, it would be the result of hindsight reconstruction. As the three requirements for obviousness are not met by the combination of citations, it is respectfully requested that the current obviousness rejection be withdrawn.

**The Examiner's 35 U.S. C. 103(a) Rejection - Sumida-Japanese HEI 4(1992)-48925 in view of Sugizaki Japanese (Kokai)Appln 3-115208**

The claims are also rejected as obvious over Sumida in light of Sugizaki. Sugizaki discloses a water-in-oil composition having very low levels of water, 0.5% in all the examples shown in Table 1, while the instant compositions comprise at least 60% water. One of skill in the art would understand that the behavior of such different compositions would not be the same. There would be no motivation for one of skill in the art to consider components of the Sugizaki reference with its high oil content for addition to the Sumida compositions with their much lower oil content and much higher water content. Therefore, based on the requirements given above, the cited combination does not render the instant invention obvious.

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**The Examiner's 35 U.S. C. 103(a) Rejection - Koyanagi et al. (US 5474776) in view of Motono (US 49854555)**

Claims 8-10 are rejected as being unpatentable over Koyanagi et al. in view of Motono.

Koyanagi discloses cleansing compositions comprising hydrophilic nonionic surfactants, an amphoteric surfactant, a water soluble compound containing at least one hydroxyl group, a liquid oil and water. The instant invention does not contemplate the addition of an amphoteric surfactant. The instant compositions contain nonionic surfactants and an anionic surfactant. Therefore one of skill in the art would not equate the compositions of Koyanagi with those of the instant invention, nor find motivation in Koyanagi to include an anionic. Additionally, the water content of Koyanagi's compositions and those of the instant invention varies considerably.

As previously discussed Motono discloses external preparations comprising kojic acid, or a derivative thereof, which also contain an ultraviolet absorber,  $\beta$ -cyclodextrin and ethylenediaminetetraacetic acid and have a controlled pH in the range of from 4.0 to 5.0. The polyoxyethylene sorbitol tetraoleate used in Motono is one of three surfactants used in the example, which the Examiner has cited. If one of skill in the art were to decide, even without motivation to alter Koyanagi's compositions, to make an alteration, it would take a number of formulation changes to produce any composition, which would fall within the claims of the instant invention. There would be no motivation to choose Motono from the many patents related to skin care. Then, absent the hindsight provided by the instant application, there would be no motivation to choose the polyoxyethylene sorbitol tetraoleate, from among the components disclosed as suitable for use in that citation. The combination of Koyanagi and Motono does not render the instant invention obvious.

**The Examiner's 35 U.S. C. 103(a) Rejection - Koyanagi et al. (US 5474776) in view of Sugizaki Japanese (Kokai)Appln 3-115208**

The Examiner asserts that the instant application is obvious in light of Koyanagi in view of Sugizaki. Sugizaki discloses a water-in-oil composition having very low levels of water, 0.5% in all the examples shown in Table 1, while, as previously noted, the instant compositions comprise at least 60% water. One of skill in the art would understand that the behavior of such different compositions would not be the same. There would be no motivation for one of skill in the art to consider components of the Sugizaki reference with its high oil content for addition to the Koyanagi compositions with their much lower oil content and much higher water content. Therefore, based on the requirements for obviousness given above, the cited combination does not render the instant invention obvious.

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In the absence of sufficient teaching by Koyanagi (combined with Motono or combined with Sugizaki) to support a prima facie case, it is respectfully requested that the current obviousness rejection be withdrawn.

**CONCLUSION**

Applicants have made an earnest effort to place their application in proper form and to distinguish their invention from the applied prior art. WHEREFORE, Applicants respectfully request the reconsideration of this application, withdrawal of the rejections under 35 U.S.C. §103 and allowance of Claims 1-2 and 4-10.

Respectfully submitted,

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